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**THIS DISPOSITION
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Paper No. 11
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bonakemi USA, Incorporated

Serial No. 75/693,125

Jay K. Malkin of Klaas, Law, O'Meara & Malkin, P.C. for
Bonakemi USA, Incorporated.

Toni Y. Hickey, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Simms, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Bonakemi USA,
Incorporated to register the mark COURTLINES for "interior
paint for use in painting sport floors."¹

¹ Serial No. 75/693,125 filed April 28, 1999, which alleges a
bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, when applied to the identified goods, is merely descriptive thereof. Applicant and the Examining Attorney have filed briefs. No oral hearing was requested. We affirm the refusal to register.

It is the Examining Attorney's position that the term COURTLINES immediately describes the purpose or use of applicant's goods, namely, to paint lines on a court, or stated differently, to paint "courtlines." The Examining Attorney argues that the individual words "court" and "lines" are descriptive of applicant's identified goods and that there is nothing incongruous about the combined term COURTLINES. In support of the refusal to register, the Examining Attorney made of record dictionary definitions of the words "court" and "line."² In addition, she submitted excerpts of articles from LEXIS.com which refer to basketball players dominating inside the "paint," that is

² The American Heritage Dictionary of the English Language (3d. ed. 1992) defines "court" as "an open, level area marked with appropriate lines, upon which a game, such as tennis, handball, or basketball, is played"; and "line" is defined as "a real or imaginary mark demarcating a specified section of a playing area or field."

an area around the basket which is marked with lines, and the use of paint on basketball courts. Finally, the Examining Attorney submitted printouts of several articles downloaded from the Internet. The Examining Attorney searched for "court+lines" using the Altavista search engine. One of the articles concerns the Sonoran Clubhouse tennis and golf complex in Arizona. The director of the complex is quoted as stating, in pertinent part, that "we paint our [tennis] court lines on with turf quality liquefied chalk using custom-made stencils that give us extremely precise straight lines." A second article concerns a new squash facility located at Cornell University and states, in relevant part, that "North American court lines range from one to two inches." A third article is essentially the home page of a company named Half-Court Enterprises and states, in relevant part, that "Half-Court Enterprises will paint the basketball court lines on your driveway."

Applicant, in urging reversal of the refusal to register, argues that the COURTLINES mark is unique and that there is no evidence that the mark is used by third parties to identify their interior paints for use in painting sport floors. Further, applicant argues that consumers viewing the COURTLINES mark would not immediately

connect it with applicant's identified goods, but instead would connect the mark with sporting goods, athletic shoes, or legal services. In addition, applicant argues that this case is very similar to Plyboo America Inc. v. Smith & Fong Co., 51 USPQ2d 1633 (TTAB 1999) wherein the Board held that the mark PLYBOO was not merely descriptive or generic of bamboo laminate flooring and plywood made of bamboo. Applicant has objected to the printouts of articles downloaded from the Internet on the ground that they are of "insufficient veracity." Finally, applicant submitted copies of a number of third-party registrations for marks which cover paints and argues that its should likewise be registered.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered merely descriptive thereof, rather, it is sufficient if the term

describes a significant attribute or idea about them. Moreover, the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature. See *In re Abcor Development Corp.*, supra, and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

While we have carefully considered applicant's arguments, we find that COURTLINES is merely descriptive of the identified goods.

First, we should point out that applicant's objection to the printouts of articles downloaded from the Internet is not well taken. The Examining Attorney timely made the printouts of record and provided the web addresses at which the articles appeared. In addition, the date each article was downloaded was also provided.

In this case, applicant does not dispute that lines are painted on sport floors or courts. Moreover, the Internet articles show that lines are painted on basketball and tennis courts, in particular. Thus, when the mark

COURTLINES is used for the identified goods, it directly conveys information regarding the use of the goods. The relevant class of purchasers will immediately understand, without any need for imagination, thought or perception, that applicant's COURTLINES paint is for painting lines on sport floors or courts.

The *Plyboo* case relied on by applicant does not require a different result herein. In *Plyboo*, there was some evidence which clearly showed that the term PLYBOO was used and recognized as a trademark for the involved goods. In this case, we have no evidence that the term COURTLINES is used and recognized as a trademark for applicant's goods.

While, of course, uniform treatment under the Trademark Act is essential, our task on this appeal, based upon the factual record before us, is to determine whether applicant's mark is registrable. As the Board has often stated, each case must be decided on its own set of facts. See, e.g., *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 225 (TTAB 1984). We are not privy to the file records of the third-party registrations applicant has submitted and thus have no way of knowing whether any of those registrations involved an initial descriptiveness refusal. We would also point out that none of the third-

party registrations cover marks containing the word "court" or "line," and none are for the specific type of paint involved in this appeal.

Finally, we should add that it is not necessary that a designation be in common usage in the particular industry in order for it to be merely descriptive. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) and cases cited therein.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.